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09/768,016	01/23/2001	Stanley B. Miller III	500	9290

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EXAMINER

TRAN, SUSAN T

ART UNIT	PAPER NUMBER
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1615

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 157

Application Number: 09/768,016
Filing Date: January 23, 2001
Appellant(s): MILLER ET AL.

MAILED
SEP 09 2003
GROUP 2900

Joseph P. Gastel
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/02/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences that will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 3 and 39 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claims 7 and 28 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Appellant's brief includes a statement that claim 38 does not stand or fall with claims 3 and 39, and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

The appellant has withdrawn claims 47 and 48 from appeal.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

4,855,276	Osborne et al.	08-1989
6,146,446	Tuma et al.	11-2000

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-6, and 38-46 rejected under 35 U.S.C. 103(a) as being unpatentable over Tuma et al. US 6,146,446.

Tuma teaches shaped adsorbent articles useful in electronic device (see abstract). The article comprising mixtures of adsorbent materials includes activated carbon, silica gel, calcium carbonate, potassium carbonate, potassium permanganate, calcium sulfate, and sodium carbonate; and binder includes microcrystalline cellulose, starch, sodium silicate, and polyvinylpyrrolidone (columns 5-6). The adsorbent article can be formed using compression molding or tablet-forming method (id, column 9, lines 47-62). Tuma does not teach first acid salt being primarily associated with the

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adsorbent, and second acid salt being primarily associated with the binder. However, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Thus, it would have been obvious for one of ordinary skill in the art to, by routine experimentation determine a suitable method with the expectation of at least similar result, because Tuma teaches an adsorbent article for the same purpose desired by the applicant, e.g., adsorbent article used in electronic devices to adsorb acid gas.

Same purpose
Same intended
" result, same properties.

Claims 7, 10-12, and 28-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuma et al., and Osborne et al. US 4,855,276.

Tuma is relied upon for the reasons stated above. Tuma is silent as to the limitation of second basic salt is associated with the binder. However, it is the position of the examiner that one of ordinary skill in the art would by routine experimentation determine a suitable process with the expectation of at least similar result, because Tuma teaches the use of adsorbent article containing the same material, same shape, and for the same purpose, absorbing acid gas to protect electronic devices from contaminants.

Tuma is silent as to the teaching of sodium or potassium bicarbonate.

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Osborne teaches adsorbent composition comprising activated carbon powder, activated alumina, water, and sodium bicarbonate (columns 5-6). Thus, it would have been prima facie obvious for one of ordinary skill in the art to prepare Tuma's adsorbent article using basic salts taught by Osborne, because the references suggest the use of basic salts in adsorbent composition to filter fluid, such as air within electronic devices. The expected result would be an adsorbent article in a variety of shapes useful to be placed in smaller spaces, such as disk drives.

Claims Allowable

Claims 19-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant argues that Tuma does not teach the limitations of a "first basic salt being primarily associated with said adsorbent, and said second basic salt being primarily associated with said binder". However, it is the examiner's position that no criticality is seen in the particular limitations. There are no unusual and/or unexpected results, which would rebut prima facie obviousness since Tuma teaches an adsorbent article useful for the same purpose, *e.g.*, shaped adsorbent articles used in electronic devices for absorbing acid gas, filtering fluid and air (see abstract, columns 1 and 9).

Applicant argues that it would not have been obvious for one of ordinary skill in the art to modify Tuma's adsorbent article to produce the composition wherein a first basic salt being primarily associated with the adsorbent, and said second basic salt being primarily associated with the binder. In response to applicant's argument, no criticality in the mixing steps since the prior art teaches the method of making an acid-gas absorbing tablet for the same purpose using the same ingredients. The burden is shifted to applicant to establish some criticality in the order of mixing. There are no ratios and/or percentages set forth that impart a distinction over the process disclosed by the prior art. Note that claim 34 clearly acknowledges that any proportions may be used.

While the generic claims claimed the particular limitation, dependent claims 4, 5, 10, 11, 29, 32, 35, 41, 42, 44, and 45 recited first and second basic salts can be selected from the same salt groups, such as, sodium and potassium carbonates or bicarbonates. Although there are dependent claims that recited first acid salt is selected from the carbonates salt group, and second acid salt is selected from the bicarbonates salt group, applicant's specification at page 5 disclosed potassium carbonate or any other suitable basic salt (first basic salt) may be used with the binder. Accordingly, no criticality is seen in the limitation of first basic salt is associated with the adsorbent, and second basic salt is associated with the binder.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



S. Tran
September 4, 2003

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